17.   (AS NEW) A slide show system, comprising:

a browser unit to obtain information using address information defined on an information network and to output the obtained information;

a storage unit to store a predetermined correspondence relationship between a plurality of pieces of address information and a plurality of sequence numbers representing a user-specified output sequence; and

a control unit to increment a control variable indicating one of the sequence numbers, to refer to the correspondence relationship to obtain address information corresponding to a sequence number indicated by the variable, to inform the obtained address information to the browser unit according to a predetermined output sequence that is specified by a user, and to instruct output of information corresponding to the informed address information.

REMARKS

In the Office Action mailed on May 2, 2002, claims 1, 10, and 11 were rejected under 35 U.S.C. § 102(e) as being anticipated by Borman et al. (U.S. Patent No. 5,890,172) ("Borman"); claims 2-7 and 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borman; and claims 8-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borman in view of Gorbet et al. (U.S. Patent No. 6,072,480) ("Gorbet") and Qureshi et al. (U.S. Patent No. 6,084,582) ("Qureshi"). The foregoing rejections are respectfully traversed.

Claims 1-17 are pending in the subject application, of which claims 1, 12-14, and 17 are independent. New claims 15-17 are added. Care has been exercised to avoid the introduction of new matter.

Rejections Under 35 U.S.C. § 102(e) (Borman):

Borman discusses a computer-implemented system for retrieving information through a browser connected to a network (Borman, Abstract). The system parses through a hypertext document (such as an Internet web page) for hyperlinks and compiles a list of the hyperlinks contained therein (Borman, Summary). They system then does one of three things: (a) the system navigates to one of the first, prior, next, or last hyperlink in the list in response to a command by the user to navigate to another hyperlink; (b) the system automatically navigates to each hyperlink in order after a predetermined interval; or (c) the system navigates to a hyperlink that is chosen by a user and displays the list of non-chosen hyperlinks in the same display, so

2

that the user can select one of the other original hyperlinks from the list without having to backtrack (Borman, Summary).

In contrast, claim 1 of the present application recites a control unit to inform the address information to the browser unit "according to a predetermined output sequence that is specified by a user," and to instruct output of information corresponding to the informed address information. Borman does not disclose or suggest informing an address information to a browser unit according to a predetermined output sequence that is specified by a user. In fact, Borman only discloses navigating sequentially through a list of hyperlinks that was created by the system or navigating through a list of hyperlinks, at the direction of a user as the user selects the next hyperlink for navigation when a current hyperlink is being displayed.

In the Examiner's Response to the Applicants' arguments, the Examiner indicated that claim 1 was anticipated by Borman because the Applicants contradicted themselves by stating that Borman discusses "navigating sequentially through a list of hyperlinks at the direction of a user." The Examiner continued by focusing on a comparison of hyperlinks to web addresses, address information, and URLs. However, the Examiner failed to note that the Applicants were not arguing that Borman did not apply to address information, but instead that Borman did not disclose or suggest informing an address information to a browser unit according to a predetermined output sequence that is specified by a user.

A key difference is that Borman only discloses the three possibilities listed above. In options (a) and (c), the output sequence is user-controlled, but not predetermined. The user must select the next hyperlink to which he desires to navigate each time he wishes to navigate to a different hyperlink. For example, a user may be viewing hyperlink A and have hyperlinks B, C, D, and E to choose from. The system in Borman then navigates to one of hyperlinks B, C, D, or E depending on the user's choice, but only after the user selects one from that group. Then, after that selection, the user must make another selection in order to view another hyperlink. The difference becomes apparent when understanding that the present invention recites an output sequence that, while user-defined, is predetermined, thereby not requiring user input prior to navigation to the next address information.

MPEP § 2131 states that "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The *identical* invention must be shown in as complete detail as is contained in the ... claim." (emphasis added) Clearly, Borman does not anticipate claim 1; therefore, claim 1 is allowable.

3

In addition to being allowable based on their dependency from allowable claim 1, claims 10 and 11 of the present application recite patentably distinguishing features of their own. For example, claim 11 recites a storage unit "to store information to be outputted corresponding to address information." Borman does not disclose or suggest storing information to be outputted. Borman discloses storing parsed HTML files (Borman, col. 6, lines 2-3). According to the system in Borman, parsed HTML files include "an advertisement, a plurality of URLs and topic descriptors corresponding to each URL" (Borman, col. 6, lines 30-32). In the present invention, the information to be outputted that is stored includes a web page to be displayed (Specification, p. 10, lines 6-9). The "URLs and topic descriptors corresponding to each URL" that are stored in Borman are not web pages, but merely the addresses thereof. In the present invention, the storage of a web page to be outputted is advantageous because the system need not be connected to a network during a presentation, and will therefore not be interrupted by connection failure (Specification, p. 10, lines 18-24). Because Borman only discloses storing URLs and their topic descriptors, it does not anticipate storing the information to be outputted. Therefore, claims 10 and 11 are allowable.

Rejections Under 35 U.S.C. § 103(a) (Borman):

The remarks set forth above are incorporated as if fully set forth herein. Claims 12-14 recite a correspondence relationship between a plurality of pieces of address information defined on an information network and "a plurality of sequence numbers of a predetermined output sequence that is specified by a user." As discussed above, Borman does not disclose or suggest a predetermined output sequence that is specified by a user.

In addition, Borman does not disclose or suggest a plurality of sequence numbers of a predetermined output sequence that is specified by a user, as the Examiner suggests. In option (b) of Borman (the relevant option for automatic navigation), the relevant sequence followed by the system is determined by the order in which the URLs were parsed by the system (Borman, col. 3, lines 35-39; col. 6, lines 30-32). The order in Borman is not specified by a user, as in the present invention. Clearly, Borman does not disclose or suggest a sequence (or sequence numbers) that is specified by a user. Therefore, claims 12-14 are allowable.

In addition to being allowable based on their dependency, directly or indirectly, from claim 1, claims 2-7 of the present application recite patentably distinguishing features of their own. For example, claim 2 recites "a storage unit to store a user-specified correspondence relationship

4

Serial No.: 09/244,043

between a plurality of pieces of address information and a plurality of sequence numbers representing the output sequence." (emphasis added) The rejection, in item 5 on page 4 of the Office Action, states that it would have been obvious to use sequence numbers to know the correct succession of HTML files to load. However, claim 2 recites that the plurality of sequence numbers is <u>user-specified</u>.

The Examiner, in his Response to the Applicants' Arguments, goes on to suggest that the Applicants re-read the rejection to understand the reasons for obviousness. The Applicants are fully cognizant of the Examiner's attempts to render claim 2 obvious by merely stating that it "is notoriously well known in the art when using sequential addresses and slideshows to, as stated in the previous office action for reasons of obviousness, at the minimum, internally store sequence numbers in order to know which the previous and next files to display would be." The Applicants respectfully assert that the Examiner is not focusing on the issue of whether Borman discloses or suggests a user-specified plurality of sequence numbers, which it does not. If the Examiner continues to rely on an assertion that claim 2 is obvious because sequence numbers are well-known in the art, the Applicants respectfully traverse such an assertion, and request that the Examiner cite a reference in support thereof, present an affidavit supporting the same, or withdraw his reliance upon the same, as required by MPEP § 2144.03. Further, with respect to core factual findings in a determination of patentability, the Examiner cannot simply reach conclusions based on his own understanding or experience, or on an assessment of what would be basic knowledge or common sense. In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Rather, the Examiner must point to some concrete evidence in the reference in support of his findings. Id.

MPEP § 706.02(j) requires that, for a rejection under § 103, "the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." Again, as stated above, claim 2 permits the user to specify a sequence for display that may differ from the system's compilation of the pieces of address information, for example, in preparing a slide show, and have the system display the sequence automatically without the user's real time input. Clearly, claims 2-7 are not disclosed or suggested by Borman, and are therefore allowable.

5

Rejections Under 35 U.S.C. § 103(a) (Borman, Gorbet, and Qureshi):

The remarks set forth above are incorporated as if fully set forth herein. Gorbet discusses a mechanism for designating, creating, and playing custom music soundtracks to accompany an electronic slide show (Gorbet, col. 3, line 66 – col. 4, line 1).

Qureshi discusses a mechanism for recording audio, and in particular audio narration, to accompany a set of slides stored on a computer storage medium (Qureshi, col. 3, lines 35-37).

MPEP §2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The only explanation given by the Examiner regarding the motivation to combine the references is that "clearly it was common at the time the invention was made to link audio, whether it is music or narration, with electronic slideshow systems. Therefore, in order to give a user the greatest flexibility in viewing slideshows, with information taken from addresses on a communication network, it would have been necessary to have the features of providing an audio accompaniment." The Examiner has presented no actual, objective evidence that it was common at the time to link audio with electronic slideshow systems. Further, the Examiner's sole reason for supporting the motivation to combine the references is that it would have been necessary to do so to gain the greatest flexibility. The Examiner has not met his burden in establishing that the combination of references is proper. Therefore, claims 8 and 9 are allowable. However, in the event that the combination is upheld as proper, the Applicants will

6

address the combination for purposes of argument.

Assuming arguendo that such a combination is proper, the combination of Borman, Gorbet, and Qureshi discloses a computer-implemented system for retrieving information through a browser connected to a network. The system parses through a hypertext document (such as an Internet web page) for hyperlinks and compiles a list of the hyperlinks contained therein. The system plays audio music or narration while navigating the list of hyperlinks in one of three ways: (a) the system navigates to one of the first, prior, next, or last hyperlink in the list in response to a command by the user to navigate to another hyperlink; (b) the system automatically navigates to each hyperlink in order after a predetermined interval; or (c) the system navigates to a hyperlink that is chosen by a user and displays the list of non-chosen hyperlinks in the same display, so that the user can select one of the other original hyperlinks from the list without having to backtrack.

In contrast, and in addition to being allowable based on their dependency, directly or indirectly, from claim 1, claims 8 and 9 of the present application recite patentably distinguishing features of their own. For example, claim 9 recites that the control unit determines sound information to be outputted "according to a <u>user-specified</u> sequence number of the address information representing the output sequence." (emphasis added) The combination of references does not disclose or suggest determining sound information to be outputted according to a <u>user-specified</u> sequence number of the address information. The Examiner, in his Response to the Applicants' Arguments, stated that it would have been obvious to output sound information. However, in claim 9, the sound is outputted according to a sequence number, which is <u>user-specified</u>, whereas the combination of references does not disclose or suggest outputting sound according to a <u>user-specified</u> sequence number (see discussion in regards to Borman, above). Therefore, claims 8 and 9 are not rendered obvious by the combination of references and are therefore allowable.

New Claims:

New claims 15-17 are added herein.

New claim 15 recites that "the address information is a web page." Support for new claim 15 may be found in the Specification on page 10 at lines 6-9.

New claim 16 recites that "the system does not require manual advancement of the

7

address information by the user." Support for new claim 16 may be found in the Specification on page 10 at lines 13-15.

New claim 17 recites "a browser unit to obtain information using address information defined on an information network and to output the obtained information; a storage unit to store a predetermined correspondence relationship between a plurality of pieces of address information and a plurality of sequence numbers representing a user-specified output sequence; and a control unit to increment a control variable indicating one of the sequence numbers, to refer to the correspondence relationship to obtain address information corresponding to a sequence number indicated by the variable, to inform the obtained address information to the browser unit according to a predetermined output sequence that is specified by a user, and to instruct output of information corresponding to the informed address information." Support for new claim 17 can be found in the Specification on page 24 at lines 6-19 and in Figure 9.

None of the foregoing references, taken alone or in combination, discloses or suggests the same. Therefore, new claims 15-17 are allowable.
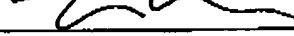
Withdrawal of the foregoing rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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8